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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

KOLS.047PA

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on

Signature

Typed or printed name Rennae Johnson

Application Number

10/659,777

Filed

09/10/2003

First Named Inventor

HAVERINEN

Art Unit

2617

Examiner

Ajayi, J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.
Registration number 57,125

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Erin M. Nichols

Typed or printed name

952-854-2700

Telephone number

January 16, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Appellant:	Haverinen	Examiner:	Ajayi, J.
Serial No.:	10/659,777	Group Art Unit:	2617
Filed:	September 10, 2003	Docket No.:	KOLS.047PA
Title:	HANDOVER		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 16, 2008.

By:

Rennae Johnson

**APPELLANT'S STATEMENT IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellant in compliance with the USPTO OG Notice of 12 July 2005 on New Pre-Appeal Brief Conference Pilot Program. Appellant is requesting a pre-appeal brief conference on the belief that the rejections of record are clearly not proper and are without basis. Appellant's request is based upon a clear legal or factual deficiency in the rejections, rather than an interpretation of the claims or the prior art teachings. As such, Appellant believes this request for pre-appeal brief review is appropriate.

Appellant notes that the citation for the secondary reference relied upon in the rejections is incorrect in that the cited publication number (2002/0080752) corresponds to the Johansson reference. The identified Corson reference has a publication number of 2004/0068578. Appellant has assumed that the intended secondary reference is Corson (2004/0068578); however, if this assumption is incorrect, Appellant requests an explanation and an opportunity to respond.

Each of the § 103(a) rejections of the pending claims is based primarily on the teachings of U.S. Publication No. 2002/0141369 by Perras (hereinafter "Perras"). For example, in the Office Action Perras is asserted as teaching each of the limitations of each of the independent

claims (Claims 1, 9, 13, 16 and 19) except for “detecting a need to change the connection of the terminal”.

While Appellant has multiple issues for appeal, the primary purpose for submitting this particular request for review concerns omissions of essential elements required for a *prima facie* obviousness rejection. Specifically, several of the limitations of the independent claims are not taught or suggested by Perras, contrary to the assertions in the final Office Action (dated September 19, 2007), or by any of the other asserted references as asserted in the Advisory Action (dated December 20, 2007).

The example limitations at issue for purposes of this request for review relate to 1) allocating a tunneling IP address in a first access device for a tunnel to a corresponding host, and 2) transferring that tunneling IP address from the first access device to a second access device. To establish a *prima facie* § 103(a) rejection of at least the independent claims, these limitations must be present in Perras or Corson, as the Examiner alleges.

The Examiner’s asserted alignment of the elements of Perras’ Fig. 1, along with the specific teachings of Perras, fails to at least teach allocating a tunneling IP address in a first access device for a tunnel to a corresponding host. To better illustrate this deficiency the alignment of the teachings of Perras to the claims is shown in the table below, using for example, the limitations of independent Claim 1.

Appellant’s Claim 1	Perras
wireless terminal	mobile station 102
host	terminal node (based on cited paragraph 20)
first access device	first service node (assumed as 112a)
second access device	second service node (assumed as 112b)

Contrary to the assertion at page four of the Office Action, the unique address (apparently asserted as corresponding to the claimed tunneling IP address) discussed in relied-upon paragraph [0020] of Perras is not allocated in the first service node 112a (asserted as corresponding to the claimed first access device). Rather, paragraph [0019] (specifically lines 9-10) indicates that the asserted unique address is originally assigned at the terminal node (the asserted host). Thus, the asserted alignment of Perras does not correspond to the claimed limitations as the alignment would have the asserted tunneling IP address assigned in the device at the opposing end of the tunnel than required by the claimed limitations – at the host (terminal

node) instead of the first access device. Since Corson has not been asserted as teaching, or shown to teach, these limitations, and Perras, which is solely relied upon as teaching these limitations, does not correspond to the claimed limitations, the asserted combination of teachings must also fail to teach at least these limitations. Without a presentation of correspondence to each of the claimed limitations, each of the § 103(a) rejections is improper.

With respect to the limitations directed to transferring the tunneling IP address from the first access device to a second access device, the Examiner appears to acknowledge in the Advisory Action that such limitations are not taught by Perras. Instead, the Examiner asserts that a newly-cited portion of Corson (paragraph [0133]) teaches such limitations. However, the reliance on these new teachings of Corson is also misplaced. Each of the independent claims requires that a tunnel be formed between a corresponding host and an access device (*see, e.g.*, Claim 9). In contrast, the asserted temporary tunnel of Corson is established between two access routers (paragraph [0133] and acknowledged in the Advisory Action) and makes no mention of forming or maintaining a tunnel between a first access device and a corresponding host. In addition, Corson's mere mention of arranging a temporary tunnel does not teach or suggest transmitting a tunneling IP address and, more specifically, a tunneling IP address for a tunnel formed between an access device and a corresponding host, as claimed. Thus, the asserted tunnel of Corson does not correspond to the claimed tunnel and Corson's mere arrangement of a tunnel fails to teach or suggest transferring the claimed tunneling IP address. Since neither of the asserted references teaches at least these limitations, any combination of Perras and Corson must also fail to teach such limitations thereby rendering the rejections improper. Appellant accordingly requests that each of the rejections be withdrawn.

Appellant further maintains that the teachings of Perras teach away from the claimed invention; therefore, a skilled artisan would not modify Perras to arrive at the claimed invention. For example, Perras teaches that the endpoint of the connection (terminal node or LNS) must have functions to accommodate the mobility of the mobile station in that it is the terminal node or LNS that assigns and reassigns the unique address of Perras (paragraph [0020]). This is in direct contrast to the claimed invention and the advantages thereof as discussed at paragraph [0009] of the instant Specification. In view of this difference, the Examiner has also not articulated reasoning with the requisite rational underpinning to support the legal conclusions of obviousness. Appellant accordingly requests that each of the rejections be withdrawn.

It is respectfully submitted that there is an omission of at least one essential element needed for a *prima facie* obviousness rejection. Neither Perras nor Corson teaches or suggests at least allocating a tunneling IP address in a first access device for a tunnel to a corresponding host and transferring that tunneling IP address from the first access device to a second access device. In the Office Action, Perras is solely relied upon in each of the prior art rejections as teaching these claimed features. Because neither Perras nor Corson involve or otherwise address allocating a tunneling IP address in a first access device for a tunnel to a corresponding host and transferring that tunneling IP address from the first access device to a second access device, Appellant believes these claim limitations are improperly being overlooked, and consequently there is an omission of an essential element(s) required for a *prima facie* rejection.

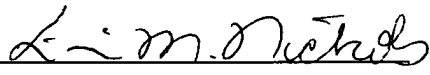
It is Appellant's position that the Examiner's reliance on Perras and Corson in each of the rejections as teaching allocating a tunneling IP address in a first access device for a tunnel to a corresponding host and transferring that tunneling IP address from the first access device to a second access device is inappropriate, as Perras and Corson do not address this.

Appellant believes that this statement, when viewed together with the prosecution history, sets forth clear grounds for a finding that the rejections based upon Perras and Corson are improper and without basis.

The undersigned is of record and with authority to prosecute the appeal on behalf of the Assignee.

Respectfully submitted,

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